

Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the claimed invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

In the Office Action dated 08/01/2008, claims 14-17, 22-23, 73-79, and 83-84 were rejected under 35 USC §103(a) as being unpatentable over Cohen (U.S. Pat. 6,060,993). Claims 18-19 were rejected under 35 USC §103(a) as being unpatentable over Cohen in view of Cragun (U.S. Pat. 5,504,675). Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. The Office must also sufficiently establish a motivation to combine or modify the teachings of the prior art in order to reach a claimed invention in accordance with MPEP 2143.01. Obviousness rejections “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, Applicant notes that independent claim 74 recites the step of “providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface.” The Office pointed to col. 4, lines 64 to col. 5, lines 1-3 of Cohen and argued that Cohen discloses “providing advertising the customers the opportunity to order display of advertising content at display screen locations selected by the advertising customers” (See Office Action dated 08/01/2008, p. 2). The Office explained further that “advertiser 28 chooses the advertisers content to display at

various locations specified by the individual advertisers.” *Id.*¹ Applicant respectfully asserts that, not only does Cohen fail to teach or suggest that advertisers order display of their content at display screen locations selected by the advertiser, the portion of Cohen cited by the Office actually teaches that it is the system that chooses the content to display at various locations.

In particular, the portion of Cohen cited by the Office states, in its entirety:

“Similarly if a monitored parameter is not in accordance with that specified for the message, e.g. vehicle travelling at rate of speed too great for zipper message, vehicle in zone where it is raining and advertiser does not wish to display sunscreen message, etc., the **controller selects** an alternate message from the memory or receives a new message from the station” (Cohen, col. 4, lines 64 to col. 5, lines 1-3) (emphasis added).

Based on this passage, as well as the remainder of Cohen, it is clear that the system taught by Cohen does **not** allow advertisers to electronically order display of advertising content at display screen locations selected by the advertising customers, as recited in claim 74. Instead, this portion of Cohen explicitly states that it is *the controller* (i.e., the system), not the advertiser, that determines which display screen location specific advertising content will ultimately be displayed on. Because Cohen does not discuss providing advertising customers the opportunity to electronically order display of advertising content at display screen locations selected by the advertising customers via an advertising customer interface and the Office has not cited any other reference disclosing this feature to combine with Cohen, Applicant respectfully asserts that there is no reason to modify Cohen to obtain the present invention.

Further, Cohen actually teaches away from the present invention as recited by amended claim 74, and therefore it is not proper to modify or combine Cohen with any other reference to obtain the present invention. MPEP 2145. One of the “considerations” of the Cohen invention “is to provide a mobile display system of the general character described wherein message content on a vehicle mounted display is changeable as a function of a [sic] the physical location of the vehicle” (Cohen col. 2, lines 40-44). In fact, the whole point of Cohen is that it is the system, not the advertisers, that determines when and where a particular advertisement is displayed based on where a moving display screen is located at any particular time. This clearly

¹ The electronic ordering and customer interface aspects of this limitation were addressed separately by the Office, and, accordingly, will be discussed in more detail below.

teaches away from providing an advertiser the opportunity to select particular display screen locations, as recited in claim 74. Cohen suggests that advertising content should be designated for display in a particular location zone, instead of selecting a particular display screen location. In the system described in Cohen, the advertising customer does not have any control over the identity of the displays temporarily located in a particular zone, which is contradictory to the limitation recited in claim 74 that the advertising content should be displayed at display screen locations selected by the advertising customers. Allowing a customer to select a particular display, regardless of location, as recited in claim 74, directly contradicts the goal of Cohen wherein the transient physical location of a display dictates what advertisement will be displayed. Consequently, Cohen should not be modified or combined with any other reference to obtain the present invention, as doing so would defeat the primary purpose of the system described in Cohen.

In addition, Applicant notes that claim 74 recites, and Cohen fails to teach or suggest, the step of “receiving advertising content from the advertising customers via an electronic communications link.” The Office argued that Cohen discloses such a step by pointing to col. 4, line 64, to col. 5, lines 1-3, and col. 5, lines 24-28. The Office added that Cohen teaches “receiving advertisers profiles and customer preferences based on the location and weather” (See Office Action dated 08/01/2008, p. 2). Applicant respectfully asserts that the sections of Cohen cited by the Office fail to disclose or suggest receiving advertising content from the advertising customers via an electronic communications link. As noted above, col. 4, line 64, to col. 5, lines 1-3, of Cohen discusses the selection of an alternate message by the system based on a monitored parameter. This portion of Cohen does not in any way concern the receipt of advertising content at all, let alone receipt of advertising content from the advertising customers via an electronic communications link, as recited in claim 74.

Similarly, the second portion of Cohen cited by the Office also does not discuss receipt of advertising content from the advertising customers via an electronic communications link. In particular, col. 5, lines 24-28, states: “Pursuant to the invention, the individual fixed location stations 20, 22 and 24 store advertiser profiles, message content and coordinated scheduling data. The stations transmit data to the vehicle controller in the form of programming data, message content and scheduling information.” This passage from Cohen merely discusses storage of

message content and associated data, such as advertiser profiles and coordinated scheduling data. It does not describe at all how any of the information (i.e. advertiser profiles, message content and coordinated scheduling data) was received by the system or whom the information was received from. In fact, the only mention of any type of communication between the advertising customer and the system is found in a single sentence at col. 5, lines 21-23: "The advertiser billing is transmitted to an advertiser 28 via conventional mail, E-mail, facsimile or other means." This one-way communication clearly does not even suggest the electronic receipt of advertising content from advertisers via an electronic communication link. Therefore, because Cohen does not discuss receipt of advertising content from advertising customers via an electronic communication link, and the Office has not cited any other reference disclosing this feature to combine with Cohen, Applicant respectfully asserts that there is no reason to modify Cohen to obtain the present invention.

Applicant recognizes that if advertising content is going to be displayed, then that content would need to be provided to the system in some manner. However, that alone does not provide adequate grounds to suggest that Cohen teaches "receiving advertising content from the advertising customers via an electronic communications link" as recited in claim 74. Based on the cited portions of Cohen, the advertising content could be communicated to the system in any number of ways and by anyone, including someone other than the advertiser. For example, the advertiser may use regular U.S. mail to send in a hard copy of the advertising content (such as a compact disc) to a company. Then, a representative of the company may access the system and upload the content to the system. In this scenario, the advertiser may not have any access at all to the system, but his content could still be received by the system. The cited portions of Cohen are simply too vague and do not provide enough detail to satisfy the requirements for rejection under 35 U.S.C. §103.

Further, Applicant respectfully submits that, based on Figure 3, Cohen actually teaches away from receiving advertising content from an advertising customer via an electronic communication link. As described in Cohen, Figure 3 illustrates "data communication flow paths" between various components of a system (col. 3, lines 36-39). Applicant notes that, while Figure 3 includes a block purporting to represent an advertiser (block 28), all three of the data communication flow paths that are associated with the advertiser's block (28) lead *toward* the

advertiser's block (28), with none leading *away from* the advertiser's block (28). If Cohen purportedly teaches "receiving advertising content from the advertising customers via an electronic communications link" why does Figure 3 not show any data communication flow paths leading *away from* the advertiser's block (28)? In fact, all of the other blocks in Figure 3 have arrows in both directions (i.e., to and from communicating components) for every single communication flow path. Thus, it is clear that the unidirectional nature of the arrows representing the data communication flow paths that are directly associated with the advertiser's block (28) in Figure 3 was intentional and not trivial.

The specification of Cohen further supports the conclusion that Figure 3 of the Cohen actually provides evidence of teaching away from the limitations recited in claim 74. In particular, the only electronic activity involving the advertiser described in Cohen is the advertiser *receiving* billing via "e-mail, facsimile, or other means" (col. 5, lines 21-23). This is consistent with the only data communication flow paths that are associated with the advertiser's block (28) in Figure 3 leading *toward* the advertiser's block (28), with none leading *away from* the advertiser's block (28). Given the above-noted teaching of Figure 3, Applicant respectfully submits that Cohen actually teaches away from receiving advertising content from the advertising customers, as recited in claim 74. Consequently, Cohen should not be modified or combined with any other reference to obtain the present invention.

Additionally, Applicant notes that claim 74 recites "providing advertising customers the opportunity to *electronically* order display of advertising content at display screen locations selected by the advertising customers *via an advertising customer interface*." As noted above, the Office addressed the electronic ordering and customer interface aspects separately from the other aspects of this limitation. In particular, the Office argued that Cohen teaches "receiving advertisers profiles, the advertisers choosing where and under what weather conditions (i.e. scheduling) to display the advertisements" (See Office Action dated 08/01/2008, p. 3). The Office pointed to col. 2, lines 58-61; col. 4, lines 54 to col. 5, lines 1-3; and col. 5, lines 24-27 as support for this argument. The first section of Cohen cited by the Office states: "A still further aspect of the present invention is to provide a mobile display system of the general character described wherein specific advertisements are displayed when and where the advertisers choose" (See col. 2, lines 58-61). The other two excerpts are discussed above. As pointed out above,

claim 74 recites that the advertising customers are able to electronically order display of advertising content and select display screen locations via an advertising customer interface. The sections of Cohen cited by the Office only vaguely refer to allowing advertisers to choose where and when advertisements are displayed, and do not mention allowing advertisers to select specific display locations as recited in claim 74. In fact, the Office admitted that “Cohen is silent as to the means used by the advertisers to order and schedule the display” (See Office Action dated 08/01/2008, p. 3).

In order to overcome Cohen’s deficiency regarding electronic ordering and the use of an advertising customer interface, the Office took Official Notice “that it is old and well known at the time of Applicant’s invention to electronically by means of a website and the like to order advertisements from a content provider” and argued that “it would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included in the system of Cohen electronically [sic] means for ordering because such a modification would provide the convenience of ordering using such known methods as the internet.” *Id.* The Office’s position is provided without any evidentiary support whatsoever, and falls far short of the standard required in order to properly take Official Notice. See MPEP 2144.03. In particular, the facts alleged by the Office are not “capable of instant and unquestionable demonstration as being well-known” as required by MPEP 2144.03. To the extent that websites were generally known at the time of the invention, that does not automatically mean that permitting advertisers to order the display of advertising content at selected display locations via an advertising customer interface was also known. Applicant therefore asserts that the Examiner must produce some supporting evidence in order for such Official Notice to be proper.

Accordingly, for all of the reasons stated above, Applicant respectfully submits that the combined art of record fails to render present claim 74 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Similarly, when rejecting claims 22-23, the Office took Official Notice “that it is old and well known in the imaging arts to detect and automatically calibrate the defective pixels in order to improve the image” (See Office Action dated 08/01/2008, p. 4). As with the other instance of Official Notice discussed above, Applicant respectfully submits that the facts asserted are not

capable of instant and unquestionable demonstration as being well-known. (MPEP 2144.03). Applicant therefore asserts that the Examiner must produce some supporting evidence in order for such Official Notice to be proper. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claims 22-23 obvious in accordance with MPEP 2143, and respectfully requests that the rejections be withdrawn.

With respect to dependent claims 15-17, Applicant respectfully submits that the art of record fails to teach or suggest all of the limitations recited in each of these claims in accordance with MPEP 2143.03. In particular, claim 15 recites reviewing content prior to display for appropriateness. Claim 16 recites verifying the displaying of the content, and claim 17 recites the method of claim 16 wherein the verifying comprises capturing image and time data of the display of the content. The Office argued that Cohen “further teaches verifying the display for appropriateness of the time and content of the display” and pointed again to col. 4, lines 64- col. 5 lines 1-3 (See Office Action dated 08/01/2008, p. 4). As discussed above, this portion of Cohen discusses the selection of an alternate message by the system based on a monitored parameter. It says absolutely nothing about verifying appropriateness of content prior to display, nor verifying the display of content. Neither this portion nor any other portion of Cohen discusses reviewing the content for appropriateness prior to display, as recited in claim 15. Similarly, the cited section of Cohen also fails to disclose verifying that the content was actually displayed, and, more particularly, verifying that the content was actually displayed by capturing image and time data, as recited in claims 16 and 17. Because Cohen does not discuss the limitations recited in claims 15-17 and the Office has failed to cite any other art that includes such discussions, Applicant respectfully asserts that there is no reason to modify Cohen to obtain the present invention. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claims 15-17 obvious in accordance with MPEP 2143, and respectfully requests that the rejections be withdrawn.

All limitations recited in a claim must be considered when determining the patentability of the claim against the prior art, even if the claim is also rejected under 35 U.S.C. §112. See MPEP 2143.03 and 2173.06. The Office failed to address every limitation recited by several claims in the Office Action dated 08/01/2008. Specifically, the Office failed to address the limitation recited in claim 14 reciting the method of claim 74 further comprising converting a

format of the content into a single format for display. Also, in the current Office Action, the Office did not address the limitation recited in claim 73 reciting the method of claim 74, wherein the advertising content is still image content. Therefore, Applicant has not been provided with a full and fair opportunity to respond to the rejection. As a result of the Office's failure to address these limitations in the context of any rejection, any subsequent office action may not be made final. See MPEP 706.07(a). Applicant respectfully requests that the Office explicitly address each and every limitation recited in each of the claims, and explicitly address each and every argument made by Applicant herein, in any subsequent Office Action.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513)369-4811 or via e-mail at aulmer@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency, including any fees required for an extension of time not already paid for or any other required fees not already paid for, or to credit any overpayment of fees, to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,



Andrew B. Ulmer (Reg. No. 57,003)
Frost Brown Todd LLC
2500 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
513-369-4811 (direct)
513-651-6981 (fax)
aulmer@fbtlaw.com